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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/909,077
Filing Date	07/19/2001
First Named Inventor	Ashok Arasappan
Art Unit	1653
Examiner Name	David Lukton
Attorney Docket Number	IN01156

Total Number of Pages in This Submission

14

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- ☐ Fee Attached
- ☒ Amendment/Reply
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- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/Incomplete Application
- ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53

- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition
- ☐ Petition to Convert to a Provisional Application
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- ☐ After Allowance Communication to Group
- ☐ Appeal Communication to Board of Appeals and Interferences
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- ☐ Proprietary Information
- ☐ Status Letter
- ☒ Other Enclosure(s) (please identify below):
Certificate of Mailing (1pg.) ; Post Card;
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Remarks

Also enclosed:

- (1) Marked-Up Amendment - 2pgs.
- (2) Response to Restriction Requirement and Sequence Listing - 3pgs.
- (3) Sequence Listing - 4pgs.
- (4) Sequence Listing on Floppy - 1 diskette

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual	Palaiyur S. Kalyanaraman , Reg. No. 34,634
Signature	
Date	07/31/2003

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Attorney Docket No.: IN01156

Application No.: 09/909,077

Filing Date: 07/19/2001

Inventor: Arasappan et al.

PTO/SB92 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

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Documents submitted:

Response Transmittal - 1pg. ; Amendment - 3pgs

Marked-Up Amendment - 2pgs.

Response to Restriction Requirement and Sequence Listing - 3pgs.

Sequence Listing - 4pgs.

Sequence Listing on Floppy - 1 diskette ; Post Card ; Certificate of Mailing

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PATENT: IN01156

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

A. Arasappan *et al.*

Serial No.: 09/909,077

Filed: July 19, 2001

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) Examiner: D. Lukton
)
) Group Art Unit: 1653
)
)
) Atty. Docket No.: IN01156

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For: **Novel Imidazolidinones as NS3-Serine Protease Inhibitors of Hepatitis C Virus**

Commissioner for Patents
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RESPONSE TO RESTRICTION REQUIREMENT AND SEQUENCE LISTING

Sir:

This communication is an Amendment and a response to the restriction requirement issued by the Examiner on July 15, 2003, in the above-identified patent application. Included in this communication are: a response to restriction requirement, an amendment to satisfy sequence listing, a sequence listing and a floppy disk containing said sequence listing.

Claims 1-47 are currently pending in the application. The Examiner restricted the claims into four groups (as subgenera) and twelve inventions: Group 1 (R¹ limited to COR⁵, and R⁵ is limited to N(R⁹)(R¹⁰)); Group 2 (R¹ being moieties other than in Group 1); Group 3 (X limited to carbonyl or thiocarbonyl); and Group 4 (X limited to C[(R)(R')]_p). The claims were divided up into 12 different ways to match the four groups.

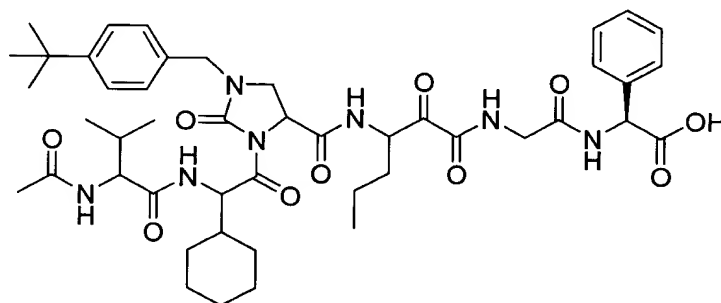
Applicants are puzzled by these restrictions. Applicants believe that all claims 1-47 form part of one and the same invention. Applicants believe that when there is a linking claim (claim 1 here) encompassing the scope of all the processes, uses, composition and compounds, it is inappropriate to restrict the invention into these various inventions. Applicants also believe that due to such commonality, a complete examination of claims 1-47 as filed would not cause undue burden. Applicants further believe that the same art search will most probably apply to the alleged separate inventions, and respectfully submits that the restriction is improper.

Under the statute "two or more independent and distinct inventions.... in one application may.... be restricted to one of the inventions." Inventions are "independent" if "there is no disclosed relationship between two or more subjects disclosed" (MPEP 802.01). The term "distinct" means that "two or more subjects as disclosed are related.... but are capable of separate manufacture, use or sale as claimed, and are patentable over each other" (MPEP 802.01). However, even when patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

In the present application, Applicants believe that the Examiner has not established a clear reason to establish the existence of any of the above 4 groups and 12 patentably distinct inventions. Reconsideration and withdrawal of the restriction requirement are, therefore, respectfully requested.

Furthermore, in order to comply with the Examiner's requirement, Applicants are electing, with traverse, the invention cited as Invention No. 3 by the Examiner as limited to groups 2 and 3. Applicants believe that this should also appropriately include the inventions classified as Invention Nos. 6, 7, 10 and 11 by the Examiner. Additionally, in order to comply with the requirement that a species be elected for examination purposes, Applicant is electing the following compound:

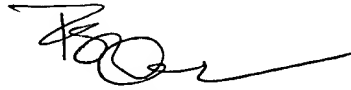


The above-shown compound occurs in Table 9 on page 67 of the application, as well as in Claim 43 (Compound No. 57).

Also enclosed herewith are an Amendment to satisfy the sequence listing, a Marked-up amendment and a sequence listing (paper copy and CRF on diskette).

If the Examiner has questions, the Examiner is invited to contact the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'Dr. Palaiyur S. Kalyanaraman', with a long horizontal flourish extending to the right.

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